

**BEFORE THE U.S. PATENT & TRADEMARK OFFICE
BOARD OF APPEALS AND INTERFERENCES**

In re application of: **DUNN ET AL.**

Serial No.: **10/757,109**

Group Art Unit: **3749**

Filed: **January 14, 2004**

Examiner: **ABBOTT, YVONNE R.**

For: **STYPTIC APPLICATOR WITH FILE**

Mail Stop Appeal Brief- Patents
Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPLICANT'S AMENDED BRIEF ON APPEAL

Sir:

This is a response to the Notification of Non-Compliant Appeals Brief, dated August 13, 2007, pertaining to Applicant's initial Appeal Brief, submitted on March 15, 2007, in relation to the Office Action, dated March 9, 2006. The response is timely by virtue of filing a one month extension of time pursuant to 1.136(a)(1) with the \$120 37 C.F.R. 1.17(a) fee. The requested corrections are provided in the amended Appeal Brief provided below.

I. The Real Party in Interest

The Real Party in Interest is Munchkin, Inc., a Delaware corporation having its primary place of business in North Hills, California.

II. Related Appeals and Interferences

There are no related Appeals or Interferences.

III. The Status of the Claims

Claims 1-40 and 47-59 are pending in this Application. Claims 41-46 have been canceled. Claim 63 has been allowed. Claims 1-13, 18-21, 23-32, 35-39, 47-62 and 64-69 stand rejected while claims 14-17, 22, 33, 34 and 40 have been objected to. The rejection of claims 1-13, 18-21, 23-32, 35-39 and 47-62 and 64-69 is being appealed.

IV. The Status of Any Amendments Filed After Final Rejection.

There are none.

V. Summary of Claimed Subject Matter

With respect to independent claim 1, a styptic applicator for pets in the preferred embodiment of the invention includes a container 16 that is disclosed on page 3, line 27 of the specification with a chamber 24 that is discussed on page 4, line 7-26 of the specification containing a styptic; a removable cap 28 that is discussed on page 4, line 17 of the specification for the container 16; an applicator device 12 for applying the styptic that is discussed on page 4, line 2 of the specification; and a filing device 14 that is discussed on page 6, lines 8-24 of the specification.

With respect to independent claim 23, a styptic applicator for pets according to the preferred embodiment of the invention includes storing means 24 for holding a styptic that is discussed on page 4, lines 7-26 of the specification; a styptic that is discussed on page 4, line 12 of the specification and is held within the storing means 24; application means 12 that is

discussed on page 4, line 2 of the specification for applying the styptic; covering means 28 that is discussed on page 4, line 17 of the specification for sealing the storing means; and filing means 14 that is discussed on page 6, lines 8-24 of the specification for filing a nail.

With respect to independent claim 47, a styptic applicator for pets according to the preferred embodiment of the invention includes a container 16 that is disclosed on page 3, line 27 of the specification with a chamber 24 that is disclosed on page 4, lines 7-26 of the specification containing a styptic that is discussed on page 4, line 12 of the specification; and a filing device 14 that is discussed on page 6, lines 8-24 of the specification.

With respect to independent claim 61, a styptic applicator for pets according to the preferred embodiment of the invention includes a container 16 that is disclosed on page 3, line 27 of the specification with a chamber 24 that is disclosed on page 4, line 7-26 of the specification for filling with a styptic that is discussed on page 4, line 12 of the specification; a removable cap 28 for the container that is discussed on page 4, line 17 of the specification; an applicator device 12 for applying the styptic that is discussed on page 4, line 2 of the specification; and a filing device 14 that is discussed on page 6, lines 8-24 of the specification, the filing device having an attachment member for being removably attached to the container 16, the attachment member being a snap mechanism that is discussed on page 6, line 16 of the specification.

With respect to independent claim 62, a styptic applicator for pets according to the preferred embodiment of the invention includes a container 16 that is disclosed on page 3, line 27 of the specification with a chamber 24 that is disclosed on page 4, line 7-26 of the specification for filling with a styptic; a removable cap 28 for the container 16 that is discussed on page 4, line 17 of the specification; an applicator device 12 for applying the styptic that is discussed on page 4, line 2 of the specification; and a filing device 14 that is discussed on page 6, lines 8-24 of the specification, the filing device 14 an attachment member for being removably attached to the container, the attachment member being a hook and loop mechanism that is discussed on page 6, lines 17-18 of the specification.

With respect to independent claim 63, a styptic applicator for pets according to the preferred embodiment of the invention includes a container 16 that is disclosed on page 3, line 27 of the specification with a chamber 24 for filling with a styptic that is disclosed on page 4, line 7-26 of the specification; a removable cap 28 for the container 16 that is discussed on page 4, line 17 of the specification; an applicator device 12 for applying the styptic that is discussed on page 4, line 2 of the specification; a filing device 14 that is discussed on page 6, lines 8-24 of the specification; and wherein the cap 28 is integral with the applicator device 12, and the applicator device 12 has a concave shape in order to hold said styptic.

With respect to independent claim 64, a styptic applicator for pets according to the preferred embodiment of the invention includes a container 16 that is disclosed on page 3, line 27 of the specification with a chamber 24 for filling with a styptic that is disclosed on page 4, lines 7-26 of the specification; a removable cap 28 for the container 16 that is discussed on page 4, line 17 of the specification wherein the cap 28 further comprises a handle 44 that is discussed on page 5, lines 5-16 of the specification for gripping the cap 28; an applicator device 12 that is discussed on page 4, line 2 of the specification for applying the styptic; and a filing device 14 that is discussed on page 6, lines 8-24 of the specification.

With respect to independent claim 65, a styptic applicator for pets according to the preferred embodiment of the invention includes storing means 24 for holding a styptic that is disclosed on page 4, line 7-26 of the specification; application means 12 for applying the styptic that is discussed on page 4, line 2 of the specification wherein the application means 12 has a concave shape in order to hold the styptic; covering means 28 that is discussed on page 4, line 17 of the specification for sealing the storing means 24; and filing means 14 that is discussed on page 6, lines 8-24 of the specification for filing a nail.

With respect to independent claim 66, a styptic applicator for pets according to the preferred embodiment of the invention includes storing means 24 for holding a styptic that is disclosed on page 4, line 7-26 of the specification; application means 12 for applying the styptic that is discussed on page 4, line 2 of the specification, wherein the application means 12 has a spout 22 that is discussed on page 5, line 18 of the specification; covering means 28 that is

discussed on page 4, line 17 of the specification for sealing the storing means 24; and filing means 14 for filing a nail that is discussed on page 6, lines 8-24 of the specification.

With respect to independent claim 67, a styptic applicator for pets according to the preferred embodiment of the invention includes storing means 24 for holding a styptic that is disclosed on page 4, line 7-26 of the specification; application means 12 for applying the styptic that is discussed on page 4, line 2 of the specification; covering means 28 for sealing the storing means 24 that is discussed on page 4, line 17 of the specification, wherein the covering means 28 further comprises a handle 44 for gripping the cap that is discussed on page 5, lines 5-16 of the specification; and filing means 14 for filing a nail that is discussed on page 6, lines 8-24 of the specification.

With respect to independent claim 68, a styptic applicator for pets according to the preferred embodiment of the invention includes a container 16 that is discussed on page 4, line 17 of the specification with a chamber 24 that is discussed on page 4, line 7-26 of the specification for filling with a styptic; and a filing device 14 that is discussed on page 6, lines 8-24 of the specification, wherein the filing device 14 has an attachment member for being removably attached to the container, and wherein the attachment member is a snap mechanism that is discussed on page 6, line 16 of the specification.

With respect to independent claim 69, a styptic applicator for pets according to the preferred embodiment of the invention includes a container 16 that is discussed on page 4, line 17 of the specification with a chamber 24 for filling with a styptic that is discussed on page 4, line 7-26 of the specification; and a filing device 14 that is discussed on page 6, lines 8-24 of the specification, wherein the filing device 14 has an attachment member for being removably attached to the container, and wherein the attachment member is a hook and loop mechanism that is discussed on page 6, lines 17-18 of the specification.

Of the claims being appealed in Section VII below, the following claims include means plus function and step plus function limitations, pursuant to 35 U.S.C. 112, sixth paragraph.

Independent claim 23 requires a styptic applicator comprising a “storing means for holding a styptic”, an “application means for applying said styptic”, a “covering means for sealing said storing means” and a “filing means for filing a nail.” The storing means is a chamber 24, which is described in the specification at page 4, lines 9-17. The application means is a concave structure 20 located on cap 28, which is described in the specification at page 4, lines 4-7 (See Figs. 1-7, part 20). The covering means is cap 28, which is described in the specification at page 4, lines 19-23 (See Figs. 1-2 and 4-7, part 28). The filing means is a file 14, which is described in the specification at page 6, lines 11-14 (See figs. 1-2, 4 and 6-7, part 14).

Dependent claims 24-26, requires the “filing means” of independent claim 23. The filing means is a file 14, which is described in the specification at page 6, lines 11-14 (See figs. 1-2, 4 and 6-7, part 14).

Dependent claim 27 requires an “attachment means for being removably attached to the container.” The attachment means is a removable attachment mechanism and may comprise, among other mechanisms, a snapping mechanism, sticky material or a hook and loop mechanism, which is described in the specification at page 6, lines 21-26.

Dependent claim 36 requires the “covering means” of claim 23. The covering means is cap 28, which is described in the specification at page 4, lines 19-23 (See Figs. 1-2 and 4-7, part 28).

Independent claims 65-66, requires a styptic applicator comprising a “storing means for holding a styptic”, a “covering means for sealing said storing means” and a “filing means for filing a nail.” The storing means is a chamber 24, which is described in the specification at page 4, lines 9-17. The covering means is cap 28, which is described in the specification at page 4, lines 19-23 (See Figs. 1-2 and 4-7, part 28). The filing means is a file 14, which is described in the specification at page 6, lines 11-14 (See figs. 1-2, 4 and 6-7, part 14).

Independent claims 67, requires a styptic applicator comprising a “storing means for holding a styptic”, an “application means for applying said styptic”, and a “filing means for filing a nail.” The storing means is a chamber 24, which is described in the specification at page

4, lines 9-17. The application means is a concave structure 20 located on cap 28, which is described in the specification at page 4, lines 4-7 (See Figs. 1-7, part 20). The filing means is a file 14, which is described in the specification at page 6, lines 11-14 (See figs. 1-2, 4 and 6-7, part 14).

Although claims 28-31, 37-39 address the filing means of claim 23, the attachment means of claim 27, a gripping means and/or the covering means of claim 23, they are not means plus function limitations since these claims specify additional structure, materials or acts for achieving the specified function.

VI. Grounds of Rejection to be Reviewed on Appeal

Appellant believes that the various issues to be considered on appeal may be concisely enumerated and summarized as follows:

Issue 1: Have Claims 1, 2, 5, 11, 18, 23, 24, 27, 30, 35, 36, 47, 48, 51, 57, 60 and 65 been improperly rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 2,273,559 to Burnett ("Burnett")?

Issue 2: Have Claims 21, 39, 64 and 67 been improperly rejected under 35 U.S.C. 103(a) as being unpatentable over Burnett in view of U.S. Patent 2,290,886 to Lenz ("Lenz")?

Issue 3: Have Claims 1-5, 9-13, 18, 19, 23-27, 29-31, 36, 37, 47-51, and 55-60 been improperly rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,762,077 to Griffiths, Jr. ("Griffiths") in view of Burnett?

Issue 4: Have Claims 1, 2, 5-9, 18, 23, 24, 27, 28, 29, 36, 47, 48, 51-55, 60-62, 68 and 69 been improperly rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,897,262 to Bratby-Carey ("Bratby-Carey") in view of Burnett?

Issue 5: Have Claims 20 and 38 been improperly rejected under 35 U.S.C. 103(a) as being unpatentable over Bratby-Carey in view Burnett as applied to claims 1 and 23 and further in view of U.S. Patent 5,443,172 to Gabriele ("Gabrielle")?

VII. Argument -- The Rejections and Appellant's Response

Issue 1: Have Claims 1, 2, 5, 11, 18, 23, 24, 27, 30, 35, 36, 47, 48, 51, 57, 60 and 65 been improperly rejected under 35 U.S.C. 102(b) as being anticipated by Burnett (2,273,559)?

MPEP 2131 sets forth the standard that must be applied in supporting an anticipation rejection under §102:

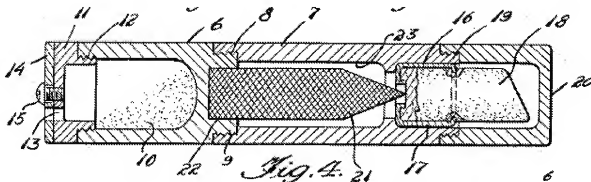
TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). >"When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001) (claim to a system for setting a computer clock to an offset time to address the Year 2000 (Y2K) problem, applicable to records with year date data in "at least one of two-digit, three-digit, or four-digit" representations, was held anticipated by a system that offsets year dates in only two-digit formats). See also MPEP § 2131.02.< "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of terminology is not required, *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Note that, in some circumstances, it is permissible to use multiple references in a 35 U.S.C. 102 rejection. See MPEP § 2131.01.

Claim 1 is an independent claim and is reproduced as follows for the convenience of the Examiners-in-Chief:

1. A styptic applicator for pets comprising:
 - a container with a chamber containing a styptic;
 - a removable cap for said container;
 - an applicator device for applying the styptic; and
 - a filing device.

Burnett discloses a receptacle that is designed for use as a vanity case, presumably for women. A copy of Figure 4 of the Burnett reference appears as follows:



Burnett's receptacle 5 is provided with a first section 6 that is designed to carry an unspecified powder, presumably a talcum powder. It further includes a nail file 21 and a section for holding lipstick 18.

There is absolutely no disclosure in the Burnett reference that the receptacle disclosed therein has any utility at all for use with pets, or that it could be used for dispensing or applying styptic material. Burnett does not disclose a container with a chamber that contains a styptic, as claim 1 requires. In addition, Burnett is not disclose an applicator device for applying a styptic as is positively set forth in claim 1. Accordingly, each and every element of claim 1 is not even remotely contained in the Burnett reference. For that reason, the §102 rejection of claim 1 based on Burnett is legally inappropriate and should be overturned.

Dependent claim 5 further recites that the filing device has an attachment member for being removably attached to the container. Burnett clearly fails to disclose such a feature. Accordingly, claim 5 is not anticipated for Burnett for the reasons set forth in regard to independent claim 1 and by virtue of the significant additional limitations contained therein.

Dependent claim 11 further recites that the filing device has a herringbone crosshatch, which is not disclosed in the Burnett reference. Accordingly, claim 11 cannot be anticipated by the reference.

Dependent claim 18 states that the cap is flush with a side of the container. Applicant respectfully submits that this limitation is not taught by the reference and that claim 18 is not anticipated for the reasons set forth above in regard to claim 1 and by virtue of the additional limitations set forth therein.

Independent claim 23 reads as follows:

23. A styptic applicator for pets comprising:
- storing means for holding a styptic;
 - a styptic held within said storing means;
 - application means for applying said styptic;
 - covering means for sealing said storing means;
 - filing means for filing a nail.

Burnett clearly fails to disclose anything that could be interpreted as a storing means for holding a styptic. Moreover, Burnett without question fails to disclose a styptic that is held within a storing means as is positively set forth in independent claim 23. In addition, the reference fails to disclose an application means for applying a styptic, as claim 23 recites. For all of these reasons, Appellant respectfully submits that Burnett cannot reasonably be considered to anticipate claim 23. Accordingly, the §102 rejection of independent claim 23 based on Burnett is legally improper and should be overturned.

Dependent claim 24 further sets forth that the filing means is located on a side of the storing means. This feature is clearly not disclosed in the Burnett reference. Accordingly, claim 24 is not anticipated by Burnett.

Dependent claim 27 further sets forth that the filing means is attachment means for being removably attached to the container. This feature is not disclosed in Burnett. Accordingly, claim 27 is not anticipated by Burnett.

Dependent claim 30 further sets forth that the filing means has a herringbone crosshatch. The nail file that is disclosed in the Burnett reference does not have a herringbone crosshatch. Accordingly, claim 30 is not anticipated by the Burnett reference.

Dependent claim 35 further specifies that the applicator means as a spout. There is no spout of any type disclosed in the Burnett reference. Accordingly, Burnett cannot reasonably be considered to anticipate claim 35.

Dependent claim 36 further sets forth that the covering means is flush with a side of the storing means. This feature is not disclosed in the Burnett reference. Accordingly, Burnett fails to anticipate claim 36.

Independent claim 47 reads as follows:

47. A styptic applicator for pets comprising:
a container with a chamber containing a styptic; and
a filing device.

Claim 47 positively sets forth a container with a chamber containing a styptic. Given the fact that the Burnett reference does not mention or infer in any way the presence of the styptic material, claim 47 cannot be anticipated by Burnett. Accordingly, the §102 rejection of independent claim 47 based on Burnett is legally improper and should be withdrawn.

Dependent claim 48 specifies that the filing device is located on a side of the container. The nail file disclosed in the Burnett reference is clearly not so located. Accordingly, claim 48 cannot be anticipated by Burnett.

Dependent claim 51 specifies that the filing device as an attachment member for being removably attached to the container. This feature is clearly not disclosed in the Burnett reference. Accordingly, claim 51 is not anticipated by Burnett.

Dependent claim 57 further sets forth that the filing means has a herringbone crosshatch. The nail file that is disclosed in the Burnett reference does not have a herringbone crosshatch. Accordingly, claim 57 is not anticipated by the Burnett reference.

Dependent claim 60 further sets forth a removable cap, which is not disclosed in the Burnett reference. Accordingly, claim 60 cannot be anticipated by Burnett.

Independent claim 65 reads as follows:

65. A styptic applicator for pets comprising:
- storing means for holding a styptic;
 - application means for applying said styptic wherein said application means has a concave shape in order to hold said styptic;
 - covering means for sealing said storing means;
 - filing means for filing a nail.

The Burnett reference clearly does not disclose a storing means for holding a styptic as is positively recited in independent claim 65. Moreover, the Burnett reference does not disclose or suggest in any way an application means for applying styptic that has a concave shape in order to hold the styptic. Accordingly, Burnett does not disclose each and every element that is positively set forth in independent claim 65. For that reason, the §102 rejection of independent claim 65 based on Burnett is legally improper and should be overturned.

Issue 2: Have Claims 21, 39, 64 and 67 been improperly rejected under 35 U.S.C. 103(a) as being unpatentable over Burnett ‘559 in view of Lenz (2,290,886)?

MPEP 2143 explains the basic requirements for making a *prima facie* case of obviousness in support of a §103 rejection:

2143 Basic Requirements of a *Prima Facie* Case of Obviousness

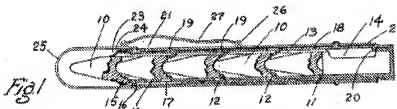
To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Dependent claim 21 depends from claim 1 and further specifies that the cap further comprises a handle for gripping the cap. In Applicants preferred embodiment, this handle is depicted in FIGURE 7 by reference numeral 44.

The Burnett reference clearly does not disclose or suggest a handle for gripping its removable cap.

The Lenz reference discloses a styptic pencil that has a removable cap, but there is no disclosure or suggestion that a handle may be provided on the removable cap. Figure 1 of the Lenz reference is shown to the right. Since neither of the applied references discloses or suggests a handle in conjunction with a removable cap, the prior art references when combined do not teach or suggest all of the claim limitations as MPEP 2143 requires.



In addition, there would have been no suggestion or incentive present that would have led a person having ordinary skill in the art to combine the reference teachings as the rejection proposes. For both of these reasons, the §103 rejection of claim 21 is legally inappropriate and should be overturned.

Claim 39 depends from independent claim 23 and further specifies that the covering means further comprises a handle for gripping the cap. Again, this feature is not disclosed or suggested in either of the applied references. Accordingly, the §103 rejection of claim 39 is legally inappropriate and should be overturned.

Independent claim 64 is reproduced below for the benefit of the Examiners-in-Chief:

64. A styptic applicator for pets comprising:

a container with a chamber for filling with a styptic;

a removable cap for said container wherein said cap further comprises a handle for gripping said cap;

an applicator device for applying the styptic; and

a filing device.

Claim 64 requires a handle for gripping the cap. It also requires an applicator device for applying a styptic. As Appellant has pointed out above, neither of the applied references disclose a handle for gripping a removable cap. In addition, neither reference discloses an applicator device for applying a styptic material. Moreover, there is no disclosure or suggestion present in either of the references or otherwise that would have led a person having ordinary skill in the art to modify the teachings of the references in order to achieve what Appellant is claiming in independent claim 64.

Accordingly, the §103 rejection of independent claim 64 is legally inappropriate and should be overturned.

Independent claim 67 is reproduced below for the benefit of the Examiners-in-Chief:

67. A styptic applicator for pets comprising:

storing means for holding a styptic;

application means for applying said styptic;

covering means for sealing said storing means, wherein said covering means further comprises a handle for gripping said cap;

filing means for filing a nail.

As Appellant has pointed out above, neither of the applied references discloses or suggests a covering means that includes a handle for gripping. Accordingly, the references when combined would not satisfy all of the limitations that are contained in independent claim 67. Moreover, there is no suggestion or incentive present that would have led a person having ordinary skill in the art to contemplate combining the references as proposed in the rejection.

In addition, there is no disclosure or suggestion in either reference of an application means for applying a styptic. The Lenz reference discloses a styptic in solid form, so there is no

need for an application means is the phrase is used in the context of this application for applying the styptic. Appellant points out that the phrase “application means for applying said styptic” is a means plus function clause under §112, 6th paragraph that must be interpreted with reference to Appellant’s specification. The USPTO must apply 35 U.S.C. §112, sixth paragraph in appropriate cases, and give claims their broadest reasonable interpretation, in light of and consistent with the written description of the invention in the application.¹ Accordingly, it would be improper to interpret “application means for applying said styptic” as encompassing the type of structure that is disclosed in the Lenz reference.

For all of those reasons, Appellant respectfully submits that the rejection of independent claim 67 is legally inappropriate and should be overturned.

Issue 3: Have Claims 1-5, 9-13, 18, 19, 23-27, 29-31, 36, 37, 47-51, and 55-60 been improperly rejected under 35 U.S.C. 103(a) as being unpatentable over Griffiths, Jr. (5,762,077) in view of Burnett ‘559?

Claim 1 is an independent claim and is reproduced as follows for the convenience of the Examiners-in-Chief:

1. A styptic applicator for pets comprising:
 - a container with a chamber containing a styptic;
 - a removable cap for said container;
 - an applicator device for applying the styptic; and
 - a filing device.

¹ See *In re Donaldson*, 16 F.3d at 1194, 29 USPQ2d at 1850.

Griffiths discloses an apparatus for manicuring nails that includes a chamber for containing a nail polish. Figure 4 of the reference is depicted to the right. There is no disclosure or suggestion in the reference of a styptic material or an applicator device for applying a styptic material. This is not surprising, because the apparatus disclosed in the reference is intended for human use, not for grooming pets, and styptic material has little utility for use in manicuring human fingernails.

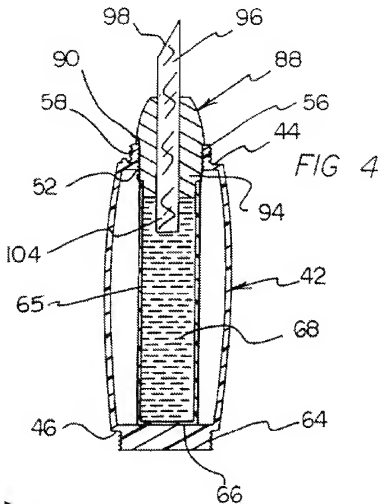
As Appellant has pointed out above, the Burnett reference does not disclose or suggest a styptic material or an applicator device for applying a styptic material.

MPEP 2143 explains the basic requirements for making a prima facie case of obviousness in support of a §103 rejection:

2143 Basic Requirements of a Prima Facie Case of Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).



Since neither of the applied references discloses or suggests either a styptic material or an applicator device for applying a styptic material, the references when combined do not teach or suggest all of the claim limitations as MPEP 2143 requires. Accordingly, there is no prima facie case of obviousness. In addition, there is no suggestion or incentive present that would have led a person having ordinary skill in the art to combine the reference teachings as proposed in the rejection.

For both of these reasons, Appellant respectfully submits that the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 2 further requires that the filing device is located on a side of the container. In Griffiths, the filing device to the extent that it exists is part of the container. It is not on the side of the container. In Burnett, the filing device is not on the side of the container, but rather is a longitudinally extending element that is internal to the container when the cap is on. Accordingly, for these reasons and for the reasons discussed above with reference to independent claim 1 the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 3 further specifies that the filing device is located on a bottom of the container. This limitation is not satisfied by either of the applied references. Accordingly, for these reasons and the reasons discussed above with reference to independent claim 1, the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 4 further specifies that the filing device is located on a top portion of the container. Again, this limitation is not satisfied by either of the applied references. Accordingly, for these reasons and the reasons discussed above with reference to independent claim 1, the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 5 further specifies that the filing device has an attachment member for being removably attached to the container. Burnett does not disclose or suggest this feature. Neither does Griffiths. Accordingly, for these reasons and the reasons discussed above with reference to independent claim 1, the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 9 further specifies that the filing device is made of Emory board material. Burnett does not disclose or suggest this feature. Neither does Griffiths. Accordingly, for these reasons and the reasons discussed above with reference to independent claim 1, the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 10 further specifies that the filing device is made of metal. While the Burnett reference discloses a metal file, Appellant respectfully submits that there is insufficient suggestion or incentive present that would have led a person having ordinary skill in the art to combine the teachings of Burnett in Griffiths in order to achieve what is set forth in claim 10. In addition, the filing device that is disclosed in Burnett is internal. In order to incorporate the internal file of Burnett into the Griffiths reference it would have to be positioned so that it was immersed in the nail polish that is contained within the Griffiths device. This would render it unusable as a filing device. Accordingly, the references actually teach away from the proposed combination. For these reasons, Appellant respectfully submits that the rejection of claim 10 is legally inappropriate and should be overturned.

Dependent claim 11 further specifies that the filing device has a herringbone crosshatch. This is not disclosed or suggested in either of the applied references. Accordingly, for these reasons and the reasons discussed above with reference to independent claim 1, the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 12 further specifies that the filing device is made of a sandpaper material. This is not disclosed or suggested in either of the applied references. Accordingly, for these reasons and the reasons discussed above with reference to independent claim 1, the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 13 further specifies that the filing device has both a course and fine crosshatch. This is not disclosed or suggested in either of the applied references. Accordingly, for these reasons and the reasons discussed above with reference to independent claim 1, the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 18 further specifies that the cap is flush with a side of the container. This is not disclosed or suggested in either of the applied references. Accordingly, for these reasons and the reasons discussed above with reference to independent claim 1, the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 19 further specifies that the cap includes a gripping surface that comprises a depression on a side for gripping the cap. This is not disclosed or suggested in either of the applied references. Accordingly, for these reasons and the reasons discussed above with reference to independent claim 1, the §103 rejection is legally inappropriate and should be overturned.

Independent claim 23 reads as follows:

23. A styptic applicator for pets comprising:

storing means for holding a styptic;

a styptic held within said storing means;

application means for applying said styptic;

covering means for sealing said storing means;

filing means for filing a nail.

Neither of the applied references discloses or suggests either a storing means for holding a styptic, a styptic that is held within the storing means or an application means for applying a styptic.

Since neither of the applied references discloses or suggests these features of the invention that are positively set forth in independent claim 23, the references when combined to not teach or suggest all of the claim limitations as MPEP 2143 requires. Accordingly, there is no prima facie case of obviousness. In addition, there is no suggestion or incentive present that would have led a person having ordinary skill in the art to combine the reference teachings as proposed in the rejection.

For both of these reasons, Appellant respectfully submits that the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 24 further specifies that the filing means is located on a side of the storing means. In Griffiths, the filing device to the extent that it exists is part of the container. It is not on the side of the container. In Burnett, the filing device is not on the side of the container, but rather is a longitudinally extending element that is internal to the container when the cap is on. Accordingly, for these reasons and for the reasons discussed above with reference to independent claim 23 the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 25 further recites that the filing device is located on a bottom of the storing means. This limitation is not satisfied by either of the applied references. Accordingly, for these reasons and the reasons discussed above with reference to independent claim 23, the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 26 further specifies that the filing means is located on the covering means. This limitation is not satisfied by either of the applied references. Accordingly, for these reasons and the reasons discussed above with reference to independent claim 23, the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 27 further specifies that the filing means has attachment means for being removably attached to the container. This limitation is not satisfied by either of the applied references. Accordingly, for these reasons and the reasons discussed above with reference to independent claim 23, the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 29 further specifies that the filing means is made of either metal, sandpaper or an Emory board material. While the Burnett reference discloses a metal file, Appellant respectfully submits that there is insufficient suggestion or incentive present that would have led a person having ordinary skill in the art to combine the teachings of Burnett in Griffiths in order to achieve what is set forth in claim 29. In addition, the filing device that is disclosed in Burnett is internal. In order to incorporate the internal file of Burnett into the Griffiths reference it would have to be positioned so that it was immersed in the nail polish that

is contained within the Griffiths device. This would render it unusable as a filing device. Accordingly, the references actually teach away from the proposed combination. For these reasons, Appellant respectfully submits that the rejection of claim 29 is legally inappropriate and should be overturned.

Dependent claim 30 further specifies that the filing means has a herringbone crosshatch. This limitation is not satisfied by either of the applied references. Accordingly, for these reasons and the reasons discussed above with reference to independent claim 23, the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 31 further specifies that the filing means has both a course and a fine crosshatch. This limitation is not satisfied by either of the applied references. Accordingly, for these reasons and the reasons discussed above with reference to independent claim 23, the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 36 further specifies that the covering means is flush with a side of the storing means. This limitation is not satisfied by either of the applied references. Accordingly, for these reasons and the reasons discussed above with reference to independent claim 23, the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 37 further specifies that the covering means includes gripping means for gripping the covering means so that the gripping means comprises a depression on a side for gripping the covering means. This limitation is not satisfied by either of the applied references. Accordingly, for these reasons and the reasons discussed above with reference to independent claim 23, the §103 rejection is legally inappropriate and should be overturned.

Independent claim 47 is reproduced as follows:

47. A styptic applicator for pets comprising:
a container with a chamber containing a styptic; and
a filing device.

Neither the Griffiths reference nor the Burnett reference discloses or suggests in any way the use of a styptic material. Moreover, there is no suggestion or incentive present that would have led a person having ordinary skill in the art to modify the combined teachings of the references in order to provide a styptic material as is positively set forth in independent claim 47. Accordingly, the §103 rejection fails to provide a prima facie case of obviousness and should be overturned.

Dependent claim 48 further specifies that the filing device is located on a side of the container. This limitation is not satisfied by either of the applied references. Accordingly, for these reasons and the reasons discussed above with reference to independent claim 47, the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 49 further specifies that the filing device is located on a bottom of the container. This limitation is not satisfied by either of the applied references. Accordingly, for these reasons and the reasons discussed above with reference to independent claim 47, the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 50 further specifies that the filing device is located on a top portion of the container. This limitation is not satisfied by either of the applied references. Accordingly, for these reasons and the reasons discussed above with reference to independent claim 47, the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 51 further specifies that the filing device as an attachment member for being removably attached to the container. This limitation is not satisfied by either of the applied references. Accordingly, for these reasons and the reasons discussed above with reference to independent claim 47, the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 55 further specifies that the filing device is made of Emory board material. This limitation is not satisfied by either of the applied references. Accordingly, for these reasons and the reasons discussed above with reference to independent claim 47, the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 56 further specifies that the filing device is made of metal. While the Burnett reference discloses a metal file, Appellant respectfully submits that there is insufficient suggestion or incentive present that would have led a person having ordinary skill in the art to combine the teachings of Burnett in Griffiths in order to achieve what is set forth in claim 56. In addition, the filing device that is disclosed in Burnett is internal. In order to incorporate the internal file of Burnett into the Griffiths reference it would have to be positioned so that it was immersed in the nail polish that is contained within the Griffiths device. This would render it unusable as a filing device. Accordingly, the references actually teach away from the proposed combination. For these reasons, Appellant respectfully submits that the rejection of claim 56 is legally inappropriate and should be overturned.

Dependent claim 57 further specifies that the filing device has a herringbone crosshatch. This limitation is not satisfied by either of the applied references. Accordingly, for these reasons and the reasons discussed above with reference to independent claim 47, the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 58 further specifies that the filing device is made of a sandpaper material. This limitation is not satisfied by either of the applied references. Accordingly, for these reasons and the reasons discussed above with reference to independent claim 47, the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 59 further specifies that the filing device has both a coarse and a fine crosshatch. This limitation is not satisfied by either of the applied references. Accordingly, for these reasons and the reasons discussed above with reference to independent claim 47, the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 60 further specifies that the cap is removable. While both of the references disclose a removable cap, Appellant respectfully submits that this limitation in conjunction with the limitations that are contained in independent claim 47 patentably define over the applied references.

Appellant respectfully requests that all of the rejections addressed above be overturned.

Issue 4: Have Claims 1, 2, 5-9, 18, 23, 24, 27, 28, 29, 36, 47, 48, 51-55, 60-62, 68 and 69 been improperly rejected under 35 U.S.C. 103(a) as being unpatentable over Brathy-Carey (5,897,262) in view of Burnett '559.

Claim 1 is an independent claim and is reproduced as follows for the convenience of the Examiners-in-Chief:

1. A styptic applicator for pets comprising:
 - a container with a chamber containing a styptic;
 - a removable cap for said container;
 - an applicator device for applying the styptic; and
 - a filing device.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Since neither of the applied references discloses or suggests either a styptic material or an applicator device for applying a styptic material, the references when combined do not teach or suggest all of the claim limitations as MPEP 2143 requires. Accordingly, there is no prima facie case of obviousness. In addition, there is no suggestion or incentive present that would have led a person having ordinary skill in the art to combine the reference teachings as proposed in the rejection.

For both of these reasons, Appellant respectfully submits that the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 2 further requires that the filing device is located on a side of the container. In Bratby-Carey, the use of an Emory board is disclosed that may be attached to the exterior of the container, but there is no explicit disclosure that it may be attached to the side of the container. In Burnett, the filing device is not on the side of the container, but rather is a longitudinally extending element that is internal to the container when the cap is on. Accordingly, for these reasons and for the reasons discussed above with reference to independent claim 1 the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 5 further specifies that the filing device has an attachment member for being removably attached to the container. Burnett does not disclose or suggest this feature. Neither does Bratby-Carey. Accordingly, for these reasons and the reasons discussed above with reference to independent claim 1, the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 6 further specifies that the attachment member is a snap mechanism. There is no disclosure or suggestion of any such structure in either of the applied references. Accordingly, for these reasons and the reasons discussed above with reference to independent claim 1, the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 7 further specifies that the attachment member is a sticky material. There is no disclosure or suggestion of any such structure in either of the applied references.

Accordingly, for these reasons and the reasons discussed above with reference to independent claim 1, the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 8 further specifies that the attachment member comprises a hook and loop mechanism. There is no disclosure or suggestion of any such structure in either of the applied references. Accordingly, for these reasons and the reasons discussed above with reference to independent claim 1, the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 9 further specifies that the filing device is made of Emory board material. Burnett does not disclose or suggest this feature. While the Bratby-Carey that is disclosed the use of an external Emory board, appellant respectfully submits that there is insufficient suggestion or incentive that would have led a person having ordinary skill in the art to combine the references as proposed in the rejection. Accordingly, for these reasons and the reasons discussed above with reference to independent claim 1, the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 18 further specifies that the cap is flush with a side of the container. This is not disclosed or suggested in either of the applied references. Accordingly, for these reasons and the reasons discussed above with reference to independent claim 1, the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 19 further specifies that the cap includes a gripping surface that comprises a depression on a side for gripping the cap. This is not disclosed or suggested in either of the applied references. Accordingly, for these reasons and the reasons discussed above with reference to independent claim 1, the §103 rejection is legally inappropriate and should be overturned.

Independent claim 23 reads as follows:

23. A styptic applicator for pets comprising:
storing means for holding a styptic;

a styptic held within said storing means;
application means for applying said styptic;
covering means for sealing said storing means;
filing means for filing a nail.

Neither of the applied references discloses or suggests either a storing means for holding a styptic, a styptic that is held within the storing means or an application means for applying a styptic.

Since neither of the applied references discloses or suggests these features of the invention that are positively set forth in independent claim 23, the references when combined to not teach or suggest all of the claim limitations as MPEP 2143 requires. Accordingly, there is no prima facie case of obviousness. In addition, there is no suggestion or incentive present that would have led a person having ordinary skill in the art to combine the reference teachings as proposed in the rejection.

For both of these reasons, Appellant respectfully submits that the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 24 further specifies that the filing means is located on a side of the storing means. In Bratby-Carey, the use of an Emory board is disclosed that may be attached to the exterior of the container, but there is no explicit disclosure that it may be attached to the side of the container. In Burnett, the filing device is not on the side of the container, but rather is a longitudinally extending element that is internal to the container when the cap is on. Accordingly, for these reasons and for the reasons discussed above with reference to independent claim 23 the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 27 further specifies that the filing means has attachment means for being removably attached to the container. This limitation is not satisfied by either of the applied references. Accordingly, for these reasons and the reasons discussed above with reference to independent claim 23, the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 28 further specifies that the attachment means is one of a snap mechanism, a sticky material or a hook and loop mechanism. This limitation is not satisfied by either of the applied references. Accordingly, for these reasons and the reasons discussed above with reference to independent claim 23, the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 29 further specifies that the filing means is made of either metal, sandpaper or an Emory board material. While the Burnett reference discloses a metal file, Appellant respectfully submits that there is insufficient suggestion or incentive present that would have led a person having ordinary skill in the art to combine the teachings of Burnett in Bratby-Carey in order to achieve what is set forth in claim 29. In addition, the filing device that is disclosed in Burnett is internal. In order to incorporate the internal file of Burnett into the Bratby-Carey reference it would have to be positioned so that it was immersed in the nail polish that is contained within the Bratby-Carey device. This would render it unusable as a filing device. Accordingly, the references actually teach away from the proposed combination. For these reasons, Appellant respectfully submits that the rejection of claim 29 is legally inappropriate and should be overturned.

Dependent claim 36 further specifies that the covering means is flush with a side of the storing means. This limitation is not satisfied by either of the applied references. Accordingly, for these reasons and the reasons discussed above with reference to independent claim 23, the §103 rejection is legally inappropriate and should be overturned.

Independent claim 47 is reproduced as follows:

47. A styptic applicator for pets comprising:
a container with a chamber containing a styptic; and
a filing device.

Neither the Bratby-Carey reference nor the Burnett reference discloses or suggests in any way the use of a styptic material. Moreover, there is no suggestion or incentive present that would have led a person having ordinary skill in the art to modify the combined teachings of the

references in order to provide a styptic material as is positively set forth in independent claim 47. Accordingly, the §103 rejection fails to provide a prima facie case of obviousness and should be overturned.

Dependent claim 48 further specifies that the filing device is located on a side of the container. This limitation is not satisfied by either of the applied references. Accordingly, for these reasons and the reasons discussed above with reference to independent claim 47, the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 51 further specifies that the filing device as an attachment member for being removably attached to the container. This limitation is not satisfied by either of the applied references. Accordingly, for these reasons and the reasons discussed above with reference to independent claim 47, the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 52 further specifies that the attachment member is a snap mechanism. This limitation is not satisfied by either of the applied references. Accordingly, for these reasons and the reasons discussed above with reference to independent claim 47, the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 53 further specifies that the attachment member is a sticky material. This limitation is not satisfied by either of the applied references. Accordingly, for these reasons and the reasons discussed above with reference to independent claim 47, the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 54 further specifies that the attachment member comprises a hook and loop mechanism. This limitation is not satisfied by either of the applied references. Accordingly, for these reasons and the reasons discussed above with reference to independent claim 47, the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 55 further specifies that the filing device is made of Emory board material. This limitation is not satisfied by either of the applied references. Accordingly, for

these reasons and the reasons discussed above with reference to independent claim 47, the §103 rejection is legally inappropriate and should be overturned.

Dependent claim 60 further specifies that the cap is removable. While both of the references disclose a removable cap, Appellant respectfully submits that this limitation in conjunction with the limitations that are contained in independent claim 47 patentably define over the applied references.

Independent claim 61 is reproduced as follows:

61. A styptic applicator for pets comprising:

a container with a chamber for filling with a styptic;

a removable cap for said container;

an applicator device for applying the styptic; and

a filing device, said filing device having an attachment member for being removably attached to the container, said attachment member being a snap mechanism.

Neither of the applied references discloses or suggests in any way a container that has a chamber for filling with a styptic or an applicator device for applying the styptic. In addition, neither of the applied references discloses a filing device that is removably attached to the container by a snap mechanism. Moreover, neither of the applied references has anything to do with a styptic applicator for pets.

MPEP 2143 explains the basic requirements for making a *prima facie* case of obviousness in support of a §103 rejection:

2143 Basic Requirements of a *Prima Facie* Case of Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Since neither of the applied references discloses an applicator device for applying a styptic material or a filing device that is attached to the container by a snap mechanism, the references when combined do not teach or suggest all of the claim limitations as MPEP 2143 requires. Accordingly, there is no *prima facie* case of obviousness. In addition, there is no suggestion or incentive present that would have led a person having ordinary skill in the art to combine the reference teachings as proposed in the rejection.

For both of these reasons, Appellant respectfully submits that the §103 rejection is legally inappropriate and should be overturned.

Independent claim 62 is reproduced as follows:

62. A styptic applicator for pets comprising:

a container with a chamber for filling with a styptic;

a removable cap for said container;

an applicator device for applying the styptic; and

a filing device, said filing device having an attachment member for being removably attached to the container, said attachment member being a hook and loop mechanism.

Neither of the applied references discloses or suggests in any way a container that has a chamber for filling with a styptic or an applicator device for applying the styptic. In addition, neither of the applied references discloses a filing device that is removably attached to the container by a hook and loop mechanism. Moreover, neither of the applied references has anything to do with a styptic applicator for pets.

MPEP 2143 explains the basic requirements for making a *prima facie* case of obviousness in support of a §103 rejection:

2143 Basic Requirements of a *Prima Facie* Case of Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine

reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Since neither of the applied references discloses an applicator device for applying a styptic material or a filing device that is attached to the container by a hook and loop mechanism, the references when combined do not teach or suggest all of the claim limitations as MPEP 2143 requires. Accordingly, there is no prima facie case of obviousness. In addition, there is no suggestion or incentive present that would have led a person having ordinary skill in the art to combine the reference teachings as proposed in the rejection.

Independent claim 68 is reproduced as follows:

68. A styptic applicator for pets comprising:

a container with a chamber for filling with a styptic; and

a filing device, wherein said filing device has an attachment member for being removably attached to the container, and wherein said attachment member is a snap mechanism.

Neither of the applied references discloses or suggests in any way a container that has a chamber for filling with a styptic. In addition, neither of the applied references discloses a filing device that is removably attached to the container by a snap mechanism. Moreover, neither of the applied references has anything to do with a styptic applicator for pets.

MPEP 2143 explains the basic requirements for making a prima facie case of obviousness in support of a §103 rejection:

2143 Basic Requirements of a Prima Facie Case of Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Since neither of the applied references discloses a filing device that is attached to the container by a snap mechanism, the references when combined do not teach or suggest all of the claim limitations as MPEP 2143 requires. Accordingly, there is no *prima facie* case of obviousness. In addition, there is no suggestion or incentive present that would have led a person having ordinary skill in the art to combine the reference teachings as proposed in the rejection.

Independent claim 69 is reproduced as follows:

69. A styptic applicator for pets comprising:

a container with a chamber for filling with a styptic; and

a filing device, wherein said filing device has an attachment member for being removably attached to the container, and wherein said attachment member is a hook and loop mechanism.

Neither of the applied references discloses or suggests in any way a container that has a chamber for filling with a styptic. In addition, neither of the applied references discloses a filing device that is removably attached to the container by a hook and loop mechanism. Moreover, neither of the applied references has anything to do with a styptic applicator for pets.

MPEP 2143 explains the basic requirements for making a *prima facie* case of obviousness in support of a §103 rejection:

2143 Basic Requirements of a *Prima Facie* Case of Obviousness

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Since neither of the applied references discloses a filing device that is attached to the container by a hook and loop mechanism, the references when combined do not teach or suggest all of the claim limitations as MPEP 2143 requires. Accordingly, there is no *prima facie* case of obviousness. In addition, there is no suggestion or incentive present that would have led a

person having ordinary skill in the art to combine the reference teachings as proposed in the rejection.

Appellant respectfully requests that all of the rejections addressed above be overturned.

Issue 5: Have Claims 20 and 38 been improperly rejected under 35 U.S.C. 103(a) as being unpatentable over Bratby-Carey in view Burnett as applied to claims 1 and 23 and further in view of U.S. Patent 5,443,172 to Gabriele ("Gabrielle")?

Dependent claim 20 depends from independent claim 1 and further specifies that the Includes a gripping surface that is made of an elastomeric material for improved gripping.

Dependent claim 38 depends from independent claim 23 and further specifies that the Includes a gripping means for gripping the covering means wherein the gripping means is made of an elastomeric material for improved gripping.

Gabrielle discloses a cap for jar lids that has an elastomeric gripping surface. This reference as nothing to do with pet grooming products or even grooming products for humans.

The first reason that the proposed combination of references used in this rejection is legally inappropriate for a §103 rejection is that the Gabrielle reference constitutes nonanalogous prior art to Applicant's field of endeavor. MPEP 2141.01(a) describes the standard for evaluating whether or not prior art is analogous:

2141.01(a) Analogous and Nonanalogous Art [R-3]

I. TO RELY ON A REFERENCE UNDER 35 U.S.C. 103, IT MUST BE ANALOGOUS PRIOR ART

The examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."); *Wang*

Moreover, there is no suggestion or incentive that would have led a person having ordinary skill in the art to contemplate providing the removable caps in either of the primary references with an elastomeric gripping surface as is disclosed in The Gabrielle reference. More specifically, there is no disclosure in either of the primary references of any problems in gripping the outer surface of the removable caps.

VIII. Conclusion

For the foregoing reasons, Appellant respectfully submits that each of the rejections should be reversed, and all claims allowed, and such a decision is respectfully solicited.

Respectfully submitted,

/John L. Knoble/

Date: September 17, 2007

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IX. APPENDIX- CLAIMS ON APPEAL

1. A styptic applicator for pets comprising:
 - a container with a chamber containing a styptic;
 - a removable cap for said container;
 - an applicator device for applying the styptic; and
 - a filing device.
2. A styptic applicator according to claim 1, wherein said filing device is located on a side of said container.
3. A styptic applicator according to claim 1, wherein said filing device is located on a bottom of said container.
4. A styptic applicator according to claim 1, wherein said filing device is located on a top portion of said container.
5. A styptic applicator according to claim 1, wherein said filing device has an attachment member for being removably attached to the container.
6. A styptic applicator according to claim 5, wherein said attachment member is a snap mechanism.
7. A styptic applicator according to claim 5, wherein said attachment member is a sticky material.
8. A styptic applicator according to claim 5, wherein said attachment member comprises a hook and loop mechanism.

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9. A styptic applicator according to claim 1, wherein said filing device is made of emery board material.
10. A styptic applicator according to claim 1, wherein said filing device is made of metal.
11. A styptic applicator according to claim 10, wherein said filing device has a herring bone cross-hatch.
12. A styptic applicator according to claim 1, wherein said filing device is made of a sand-paper material.
13. A styptic applicator according to claim 1, wherein said filing device has both a coarse and a fine cross-hatch.
14. A styptic applicator according to claim 1, wherein said cap is integral with said applicator device, and said applicator device has a concave shape in order to hold said styptic.
15. A styptic applicator according to claim 14, wherein said concave shape is triangular.
16. A styptic applicator according to claim 15, wherein said concave shape is slanted to form a funnel shape.
17. A styptic applicator according to claim 14, wherein said applicator device has a spout.
18. A styptic applicator according to claim 1, wherein said cap is flush with a side of said container.
19. A styptic applicator according to claim 1, wherein said cap comprises a gripping surface, wherein said gripping surface comprises a depression on a side for gripping said cap.

20. A styptic applicator according to claim 1, wherein said cap comprises a gripping surface wherein said gripping surface is made of elastomeric material for improved gripping.

21. A styptic applicator according to claim 1, wherein said cap further comprises a handle for gripping said cap.

22. A styptic applicator according to claim 21, wherein said handle extends into said chamber of said container.

23. A styptic applicator for pets comprising:
storing means for holding a styptic;
a styptic held within said storing means;
application means for applying said styptic;
covering means for sealing said storing means;
filing means for filing a nail.

24. A styptic applicator according to claim 23, wherein said filing means is located on a side of said storing means.

25. A styptic applicator according to claim 23, wherein said filing means is located on a bottom of said storing means.

26. A styptic applicator according to claim 23, wherein said filing means is located on said covering means.

27. A styptic applicator according to claim 23, wherein said filing means has attachment means for being removably attached to the container.

28. A styptic applicator according to claim 27, wherein said attachment means is one of the following; a snap mechanism, a sticky material, or a hook and loop mechanism.

29. A styptic applicator according to claim 23, wherein said filing means is made of one of the following; metal, sand-paper, or an emery board material.

30. A styptic applicator according to claim 23, wherein said filing means has a herring bone cross-hatch.

31. A styptic applicator according to claim 23, wherein said filing means has both a coarse and a fine cross-hatch.

32. A styptic applicator according to claim 23, wherein said application means has a concave shape in order to hold said styptic.

33. A styptic applicator according to claim 32, wherein said concave shape is triangular.

34. A styptic applicator according to claim 32, wherein said concave shape is slanted to form a funnel shape.

35. A styptic applicator according to claim 23, wherein said applicator means has a spout.

36. A styptic applicator according to claim 23, wherein said covering means is flush with a side of said storing means.

37. A styptic applicator according to claim 23, wherein said covering means comprises gripping means for gripping said covering means, wherein said gripping means comprises a depression on a side for gripping said covering means.

38. A styptic applicator according to claim 23, wherein said cap comprises a gripping means for gripping said covering means wherein said gripping means is made of elastomeric material for improved gripping.

39. A styptic applicator according to claim 23, wherein said covering means further comprises a handle for gripping said cap.

40. A styptic applicator according to claim 39, wherein said handle extends into said storing means.

47. A styptic applicator for pets comprising:
a container with a chamber containing a styptic; and
a filing device.

48. A styptic applicator according to claim 47, wherein said filing device is located on a side of said container.

49. A styptic applicator according to claim 47, wherein said filing device is located on a bottom of said container.

50. A styptic applicator according to claim 47, wherein said filing device is located on a top portion of said container.

51. A styptic applicator according to claim 47, wherein said filing device has an attachment member for being removably attached to the container.

52. A styptic applicator according to claim 51, wherein said attachment member is a snap mechanism.

53. A styptic applicator according to claim 51, wherein said attachment member is a sticky material.
54. A styptic applicator according to claim 51, wherein said attachment member comprises a hook and loop mechanism.
55. A styptic applicator according to claim 47, wherein said filing device is made of emery board material.
56. A styptic applicator according to claim 47, wherein said filing device is made of metal.
57. A styptic applicator according to claim 47, wherein said filing device has a herring bone cross-hatch.
58. A styptic applicator according to claim 47, wherein said filing device is made of a sand-paper material.
59. A styptic applicator according to claim 47, wherein said filing device has both a coarse and a fine cross-hatch.
60. A styptic applicator according to claim 47, further comprising a removable cap.
61. A styptic applicator for pets comprising:
a container with a chamber for filling with a styptic;
a removable cap for said container;
an applicator device for applying the styptic; and
a filing device, said filing device having an attachment member for being removably attached to the container, said attachment member being a snap mechanism.

62. A styptic applicator for pets comprising:

a container with a chamber for filling with a styptic;

a removable cap for said container;

an applicator device for applying the styptic; and

a filing device, said filing device having an attachment member for being removably attached to the container, said attachment member being a hook and loop mechanism.

63. A styptic applicator for pets comprising:

a container with a chamber for filling with a styptic;

a removable cap for said container;

an applicator device for applying the styptic;

a filing device; and

wherein said cap is integral with said applicator device, and said applicator device has a concave shape in order to hold said styptic.

64. A styptic applicator for pets comprising:

a container with a chamber for filling with a styptic;

a removable cap for said container wherein said cap further comprises a handle for gripping said cap;

an applicator device for applying the styptic; and

a filing device.

65. A styptic applicator for pets comprising:

storing means for holding a styptic;

application means for applying said styptic wherein said application means has a concave shape in order to hold said styptic;

covering means for sealing said storing means;

filing means for filing a nail.

66. A styptic applicator for pets comprising:

storing means for holding a styptic;

application means for applying said styptic, wherein said application means has a spout;

covering means for sealing said storing means;

filing means for filing a nail.

67. A styptic applicator for pets comprising:

storing means for holding a styptic;

application means for applying said styptic;

covering means for sealing said storing means, wherein said covering means further comprises a handle for gripping said cap;

filing means for filing a nail.

68. A styptic applicator for pets comprising:

a container with a chamber for filling with a styptic; and

a filing device, wherein said filing device has an attachment member for being removably attached to the container, and wherein said attachment member is a snap mechanism.

69. A styptic applicator for pets comprising:

a container with a chamber for filling with a styptic; and

a filing device, wherein said filing device has an attachment member for being removably attached to the container, and wherein said attachment member is a hook and loop mechanism.

X. EVIDENCE APPENDIX

There have been no submissions of evidence under 37 C.F.R. §§ 1.130, 1.131 or 1.132 in this reissue application.

XI. RELATED PROCEEDINGS APPENDIX

There have been no related decisions rendered by a court or the USPTO Board of Appeal and Interferences in this matter.